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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/050,243 | 01/16/2002 | Stephen R. Dohm | ITWO:0026 | 6362 |

7590 01/22/2004

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| EXAMINER | |
|---|---|
| SAETHER, FLEMMING | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3679 | |

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/050,243 | DOHM, STEPHEN R. | |
| | Examiner | Art Unit | |
| | Flemming Saether | 3679 | |

-- *The MAILING DATE of this communication appears on the cover sheet with th correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *08 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

***Claim Rejections - 35 USC § 103***

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Boven (US 5,807,052) in view of Bernoni (US 5,584,628). Van Boven discloses a fastener assembly comprising a stemmed washer having a standoff portion (120) and a spring washer portion (124). The spring washer portion is formed at an acute angle relative to standoff portion and having a generally conical shape which is elastically deformable (Figs. 6a and 6b). Van Boven shows an externally threaded fastener retained to the stemmed washer but, does not disclose an internally threaded fastener. Bernoni discloses a fastener assembly wherein a fastener is retained to a washer and teaches to interchange an internally threaded fastener as seen in Fig. 5 for and externally threaded fastener as seen in Figs. 1 and 3. Accordingly, at the time the invention was made, the skilled artisan would have recognized to substitute the externally threaded fastener disclosed in Van Boven with an internally threaded fastener in view of the teaching of Bernoni such that the assembly could be used in applications requiring an internally threaded fastener. Bernoni further discloses the fastener to have a flange (not labeled) and the washer to have a retaining portion comprising a skirt deformed inwardly to capture the flange (at 14) such that the fastener is rotatable relative to the washer. At the time the invention was made, the person of ordinary skill in the art would have recognized the retaining skirt as disclosed in Bernoni as an optimal means of retaining the fastener in Van Boven. The method would have been inherent in the combination.

Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Boven on view of Bernoni and further in view of applicant's admitted prior art (APA). As described above, Van Boven as modified by Bernoni discloses a fastener assembly including a stemmed washer retained to an internally threaded fastener. However, modified Van Boven does not disclose the joint wherein the stemmed, or standoff, portion of the washer extends through first and second members. In the "*Background of the invention*" applicant described a fastener assembly wherein standoff portion of a stemmed washer, extends through "one or more compressible materials" such that a traditional nut and bolt with associated washers are located on opposite sides. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to use the assembly of modified Van Boven in an application as described in the APA wherein it is required to secure one or more compressible materials together. The assembly of modified Van Boven is superior in that it provides for the spring washer on the standoff and for the standoff to be preassembled to the fastener. The spring washer would provide a biasing for a secure connection and the preassembly would facilitate assembly with the materials.

***In Response to Applicant's Remarks:***

Applicant argues that there is no motivation for the combination of Van Boven and Bernoni and that the references in fact teach away from the combination. In response, the examiner respectfully disagrees with applicant.

Applicant initially argues that the references, particularly Van Boven teach away from the combination. The examiner does not dispute applicant understanding of Van Boven however, examiner disagrees with applicant's conclusion that Van Boven teaches away from the combination. There is no question that Van Boven is intended to be used with a bolt, which inherently would be externally threaded, but, its intended use with a bolt does not make the invention inoperative with the bolt substituted with a nut. As recognized by applicant, the nut would require a threaded shaft which for the proposes in Van Boven would replace the bore (14) and extend through the opening (102) and receive the sleeve (120) with the nut. Since the opening (102) would continue to be larger than the sleeve the device of Van Boven would continue to operate as intended by still allowing for preassembly and misalignment.

Applicant next argues that the examiner has used impermissible hindsight in combining the references since the examiner has not cited elements in the references that would support the combination. In response, the examiner disagrees because, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is indeed proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the reference to Bernoni teaches that the level of ordinary skill at the time the invention was made, was such that

to include a substitution of a nut and therefore the skilled artisan would have recognized such a substitution in Van Boven. With all due respect, this is not improper hindsight since Bernoni clearly teaches the substitution was within the level of ordinary skill in the art at the time the invention was made.

Applicant lastly argues the rejection including applicant's admitted prior art (APA) but, since applicant relies on Van Boven and Bernoni not being properly combined as addressed above, no further response is believed necessary.

Finally, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Brown can be reached on 703-308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Flemming Saether
Primary Examiner
Art Unit 3679